

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: GRANDCOLAS, Michael L. et al.
Application No. 09/671,424
Filed: September 27, 2000
For: **SYSTEM AND METHOD FOR DELIVERING
FINANCIAL SERVICES**
Examiner: Ella Colbert
Group Art Unit: 3694
Confirmation No.: 5925

FILED ELECTRONICALLY

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

**REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705**

Sir:

We respectfully request reconsideration of the Patent Term Adjustment applied to the above-noted patent as provided for under 37 C.F.R. §1.705. Specifically, the Patent Term Adjustment calculation included in form PTOL-85 entitled, "Determination of Patent Term Adjustment" dated October 19, 2011:

1. incorrectly calculates the period of adjustment under 37 C.F.R. §1.703(a),
2. incorrectly calculates the period of adjustment under 37 C.F.R. §1.704, and
3. omits the period of adjustment under 37 C.F.R. §1.703(b).

Request for reconsideration of patent term adjustment based upon corrected period of delay under 37 C.F.R. §1.703(a) "Period A Delay", corrected period of delay under 37 C.F.R. §1.704

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“Applicant Delay” and the inclusion of the period of delay under 37 C.F.R. §1.70(b) “Period B Delay” is respectfully submitted.

This petition is timely filed, being filed prior to the payment of the issue fee. The payment of fee required by 37 C.F.R. under 37 C.F.R. §1.18(e) and any additional fees that may be required are authorized herewith.

This application is not subject to a terminal disclaimer.

Relevant Dates as Specified in §§1.703(a) through (e) and §1.704

ACTION	DATE	USPTO DELAY	APPLICANT DELAY
Application Filed	September 27, 2000		
“Period A” Delays			
Non-Final Office Action	January 28, 2004	+ 792 days	
Response	April 28, 2004		- 0 days
Notice of Non-Compliant Amendment	August 23, 2004	+ 0 days	
Response	December 15, 2004		- 230 days
Restriction Requirement	October 3, 2005	+ 171 days	
Response	November 2, 2005		- 0 days
Notice of Non-Compliant Response	January 26, 2006	+ 0 days	
Response	February 15, 2006		- 0 days
2 nd Non-Final Office Action	May 2, 2006	+ 0 days	
Response	November 1, 2006		- 91 days
Final Office Action	January 30, 2007	+ 0 days	
Response/Notice of Appeal	April 26, 2007		- 0 days
3 rd Non-Final Office Action	June 1, 2007	+ 0 days	
Response	August 29, 2007		- 0 days
Appeal Brief	June 13, 2007		- 0 days
Supplemental IDS	January 7, 2008		- 131 days
Examiner’s Answer	February 26, 2008	+ 0 days	
Notice of Non-Compliant Answer	February 10, 2009		
Examiner’s Answer	June 11, 2009	+ 530 days	
Notice of Non-Compliant Appeal Brief	February 18, 2009		
Response	March 13, 2009		- 0 days
Notice of Non-Compliant Answer	November 10, 2009		
Substituted Examiner’s Answer	April 5, 2010	+ 0 days	
Decision on Appeal	August 3, 2011		

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ACTION	DATE	USPTO DELAY	APPLICANT DELAY
Notice of Allowance	October 19, 2011	+ 0 days	
“Period B” Delays			
3 year allowance between filing date and filing of Notice of Appeal	April 26, 2007	+ 1307 days	
“Period C” Delays			
Notice of Appeal	April 26, 2007		
Appeal Affirmed	August 3, 2011	+ 1561 days	
Calculations			
Period A Delay		+ 1493 days	- 452 days
Period B Delay		+ 1307 days	
Period C Delay		+ 1561 days	
Overlapping Days		- 123 days	
Total		+ 3786 days	

Calculation of Periods for Patent Term Adjustment**Examination Delay Under 37 C.F.R. §1.703(a), “Period A” Delay**

“Period A” delays occur when the USPTO fails to initially act on an application within fourteen months of its filing date. An “initial action” that meets the fourteen-month time clock is a notification under 35 U.S.C. §132 or a notice of allowance under 35 U.S.C. §151. Applicant respectfully disagrees with the USPTO determination that the USPTO incurred a total of 1561 days delay under 37 C.F.R. §1.703(a). Accordingly, applicant submits the total Period A adjustment afforded to the Applicant corresponds to 1493 days.

Calculation**14 MONTHS FROM APPLICATION FILING DATE TO ISSUANCE OF INITIAL ACTION**

The filing date of the instant application is September 27, 2000 and a Non-Final Office Action (i.e. an “initial action”) was mailed January 28, 2004 and the first Non-Final Office

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Action was mailed January 28, 2004. The mailing date of the Non-Final Office Action occurred 792 days following the fourteen-month date from filing (i.e., November 27, 2001), thereby resulting in a USPTO delay of 792 days, which the Applicant does not dispute.

4 MONTHS FROM RESPONSE TO ISSUANCE OF RESTRICTION REQUIREMENT

The Response to the first Non-Final Office Action was filed December 15, 2004 and the Restriction Requirement was mailed October 3, 2005. The mailing date of the Restriction Requirement occurred 171 days following the four-month date from filing the Response (i.e., April 15, 2005), thereby resulting in a USPTO delay of 171 days.

Applicant respectfully submits that the USPTO incorrectly marked the mailing date of the Response as July 12, 2005. Applicant has attached hereto a copy of the Express Mail Certificate certifying that the Response, Request for Extension of Time and the required fees were deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on December 15, 2004 and a copy of the Express Mail address label stamped by the United States Postal Service as being received on December 15, 2004. Applicant has also attached hereto a copy of the self-addressed postcard stamped by the USPTO marking the Response, Request for Extension of Time and the required fees as received on December 15, 2004, a copy of the transmittal document and a copy of a check payable for the three month extension of time. Applicant respectfully submits that these documents evidence the correct filing date of the Response is December 15, 2004, not July 12, 2005. As such, Applicants respectfully submit that the USPTO incurred a delay of 171 days.

4 MONTHS FROM RESPONSE TO ISSUANCE OF EXAMINER'S ANSWER

The Response to the third Non-Final Office Action was filed August 29, 2007 and the Examiner's Answer was filed June 11, 2009. The mailing date of the Examiner's Answer occurred 530 days following the four-month date from filing the Response (i.e., December 29, 2007), thereby resulting in a USPTO delay of 530 days, which the Applicant does not dispute.

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PERIOD A DELAY

The total Period A adjustment afforded to the Applicant corresponds to 1493 days.

Applicant Delay Under 37 C.F.R. §1.704, “Applicant Delay”

“Applicant” delays occur when the Applicant fails to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. §1.704. Applicant respectfully disagrees with the USPTO determination that the Applicant incurred a total of 662 days delay under 37 C.F.R. §1.704. Accordingly, applicant submits the total Applicant Delay adjustment incurred corresponds to 453 days.

Calculation

SUBMISSION OF RESPONSE HAVING AN OMISSION

The first Non-Final Office Action was issued on January 28, 2004. A non-compliant Response was filed on April 28, 2004 and a compliant Response was filed on December 15, 2004. Pursuant to 37 C.F.R. §1.704(c)(7), “[s]ubmission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed”. The filing of the compliant Response occurred 230 days following the day after the non-compliant response was filed (i.e., April 29, 2004), thereby resulting in Applicant delay of 230 days, not 440 days as calculated by the USPTO.

Applicant respectfully submits that the USPTO incorrectly marked the mailing date of the Response as July 12, 2005, as discussed above. Applicant respectfully submits that the attached documents evidence the correct mailing date of the Response is December 15, 2004, not July 12, 2005. As such, Applicants respectfully submit that the Applicant incurred a delay of 230 days.

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3 MONTHS TO REPLY TO OFFICE ACTION

The second Non-Final Office Action was issued on May 2, 2006 and a Response was filed on November 1, 2006. The filing of the Response occurred 91 days following the three-month date from issuance (i.e., August 2, 2006), thereby resulting in Applicant delay of 91 days, which the Applicant does not dispute.

SUBMISSION OF SUPPLEMENTAL PAPER

The Response to the third Non-Final Office Action was filed on August 29, 2007 and the Supplemental Information Disclosure Statement was filed on January 7, 2008. The filing of the Supplemental Information Disclosure Statement occurred 131 days following the filing of the Response (i.e., August 28, 2007), thereby resulting in Applicant delay of 131 days, which the Applicant does not dispute.

APPLICANT DELAY

The reduction of patent term adjustment due to Applicant's failure to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. §1.704 totals 452 days.

Examination Delay Under 37 C.F.R. §1.703(b), "Period B" Delay

Pursuant to 37 C.F.R. §1.705(b), the USPTO must grant a patent term adjustment for the number of days that exceeds 36 months from the filing date of the application to the issue date of the application *excluding*: 1) the period following the filing of an RCE; 2) (i) following the declaration of an interference, (ii) the period of suspension of prosecution due to an interference, 3) the period the application is under seal, and 4) the period of an appeal.

35 U.S.C. § 154(b)(1)(B) states:

*(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY:
Subject to the limitations under paragraph (2), if the issue of an original patent is*

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delayed due to failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States ...the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Calculation

The instant application has a filing date of September 27, 2000 and a Notice of Appeal was filed on April 26, 2007. The date corresponding to 36 months (3 years) from filing is September 27, 2003. The "Period B" delay is therefore attributable to the period from September 27, 2003 until the date the Notice of Appeal was filed (i.e., April 26, 2007), thereby resulting in a USPTO delay of 1307 days.

Examination Delay Under 37 C.F.R. §1.703(e), "Period C" Delay

"Period C" delays occur when the Board of Patent Appeals and Interferences issues a final decision in favor of the applicant. The period of adjustment under is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed and ending on the date of a final decision in favor of the applicant. Applicant agrees with the USPTO determination that the USPTO incurred a total of 1561 days delay under 37 C.F.R. §1.703(e) for the period beginning April 26, 2007 (i.e., the date the Notice of Appeal was filed) until the issuance of a final decision in favor of Applicant (i.e., August 3, 2011).

Calculation

The Notice of Appeal was filed April 26, 2007 and a final decision in favor of Applicant was issued August 3, 2011. The total Period C adjustment afforded to the Applicant, which the Application does not dispute, corresponds to 1561 days.

Measure of Overlap of Period A and Period B Delay

In referring to the total patent term adjustment available to an applicant, in reference to Period A and Period B delays, 35 U.S.C. §154(b)(2)(A) states the following, “to the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed.”

As set forth in *Wyeth v. Kappos*, CAFC, No. 2009-1120, Fed. Cir., January 7, 2010, with respect to the foregoing, “Each period of delay” has its own discrete time span whose boundaries are defined in section 154(b)(1). That is, each has a start and an end. Before the three year mark, no “overlap” can transpire between the A delay and the B delay because the B delay has yet to begin or take any effect. If an A delay occurs on one day and a B delay occurs on a different day, those two days do not “overlap” under section 154(b)(2).”

Calculation

The Period A delay as set forth above extends from November 27, 2001 until January 28, 2004. The Period B delay as set forth above is calculated to run from September 27, 2003 until April 26, 2007. The overlapping days are therefore between September 27, 2003 and January 28, 2004, thereby resulting in 123 overlapping delays.

Calculation of Patent Term Adjustment

Applicant is entitled to the sum of the Period A delay (1493 days), the Period B delays (1307 days), and the Period C delays (1561 days) reduced the Applicant’s delays (452 days) and the overlapping days (123 days). Therefore, Applicant is entitled to **3786 days** of patent term adjustment.

Summary of Request for Correction of Patent Term Adjustment

Correction of the total patent term adjustment set forth in USPTO form PTOL-85 entitled, "Determination of Patent Term Adjustment" dated October 19, 2011, is respectfully requested.

Applicant submits that the total number of days of PTA reflected is incorrect, since:

1. The total incorrectly calculates the period of adjustment under the provisions of 37 C.F.R. §1.703(a), as calculated above according to the plain language of the statute. The Response to the first Non-Final Office Action was filed December 15, 2004 and the Restriction Requirement was mailed October 3, 2005. The period exceeding 4 months began on April 15, 2005 and concluded on October 3, 2005.
2. The total incorrectly calculates the period of adjustment under the provisions of 37 C.F.R. §1.704, as calculated above according to the plain language of the statute. The non-compliant Response was filed on April 28, 2004 and a compliant Response was filed on December 15, 2004. The period of delay began on April 29, 2004 and concluded on December 15, 2004.
3. The total failed to incorporate any adjustment of patent term under the provisions of 37 C.F.R. §1.705(b), as calculated above according to the plain language of the statute. The filing requirements under 37 C.F.R. §1.703(b) were completed September 27, 2000. The period exceeding 36 months began September 27, 2003 and concluded on April 26, 2007.

Applicants are entitled to 3786 days of patent term adjustment, namely the sum of 703(a) delay (1493 days), plus 703(b) delay (1307 days), plus 703(c) delay (1561 days), minus the period of Applicant delay (452 days) and minus overlapping days (123 days). Applicant requests that the patent term adjustment be corrected as described above.

In the event, the Patent and Trademark Office should wish to discuss this Petition, a telephone call to the undersigned is respectfully solicited.

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Conclusions

The fee set forth in 37 C.F.R. § 1.18(e) for this request is enclosed. Applicants believe no additional fees are required. Should the Examiner determine otherwise, the Commissioner is authorized to charge any underpayment of fees to Deposit Account No. 50-5193.

Respectfully submitted,

By: /John M. Harrington/
John M. Harrington
Registration No. 25,592

Date: December 30, 2011

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FAX

RECIPIENT/ PHONE NO.	FAX NO.	COMPANY/ CITY, STATE, COUNTRY
Examiner Colbert	571-273-6741	US Patent Office Alexandria, VA

John M. Harrington
FROM

22
PAGES (WITH COVER)

REFERENCE NO

T0091/196411
CLIENT/MATTER NO.

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COMMENTS

Serial No. 09/671,424

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In re application of: **Grandcolas, et al.**
For: **SYSTEM AND METHOD FOR
DELIVERING FINANCIAL SERVICES**
Serial No.: 09/671,424
Express Mail No.: EV 463357395 US

The Following Was Received by the PTO:

- ☒ Express Mail Certificate (No. EV 463357395 US);
- ☒ Transmittal (*In Duplicate*);
- ☒ Petition for Extension of Time Under 37 CFR 1.136(a);
- ☒ Amendment and Response;
- ☒ Check for \$1,020.00

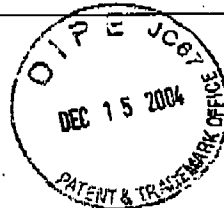
Date Mailed to PTO: December 15, 2004
Client Matter No.: T0091/196411 (*Config. Apps*)

In re application of: **Grandcolas, et al.**
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EXPRESS MAIL CERTIFICATE

EV463357395US

"Express Mail" mailing label number: EV 463357395 US

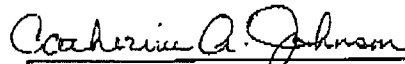
Date of Deposit: December 15, 2004

Type of Document(s): Transmittal (*In Duplicate*);
Petition for Extension of Time
Under 37 CFR 1.136(a);
Amendment and Response;
Check for \$1,020.00; and
Return Postcard

Serial No.: 09/671,424

Date Filed: September 27, 2000

I hereby certify that the documents identified above are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and are addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Catherine A. Johnson

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Grandcolas, et al.
Application No. : 09/671,424
For : **SYSTEM AND METHOD FOR
DELIVERING FINANCIAL SERVICES**
Filed : September 27, 2000
Examiner : Shih, S.
Art Unit : 3624

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Transmitted herewith are copies of the following document(s) for filing in the
above-identified application:

Petition for Extension of Time Under 37 CFR 1.136(a);
Amendment and Response;
Check for \$1,020.00

Shown below are the fees for the presentation of the amended claims:

	Claims Remaining	Highest # Previously Paid For	Extra	Rate	Fee
TOTAL	36	50	0	\$50	\$ 0
Ind. Cls.	4	4	0	\$200	\$ 0
Multiple Dependent Claim Added.....					NO
TOTAL					\$ 0

The Commissioner is hereby authorized to charge any deficiency to Deposit
Account Number 50-1458. A duplicate of this transmittal is attached for that purpose.

Respectfully submitted,

Date: 12/15/2004
KILPATRICK STOCKTON LLP
607 14th Street NW, Suite 900
Washington, DC 20005
(202) 508-5800

By: Goran P. Stojkovich
Goran P. Stojkovich (Reg. No. 45,841)